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10/713,598	11/14/2003	Carol Rudolph	4000335-148192	2011

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EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/713,598

Applicant(s)

RUDOLPH, CAROL

Examiner

Bret C Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 9-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 and 9-24 is/are rejected.  
7) ☒ Claim(s) 1,15,22 and 24 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 15, 22 and 24 are objected to because of the following informalities: claims 1 and 15, beginning at lines 19 and 18, respectively, it has been held that the functional “whereby” statement does not define any structure and accordingly cannot serve to distinguish [*In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957)]; and, claims 22 and 24, line 1 of each, “liter” should be --litter--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102 and/or 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 9 – 11, 15 – 19 and 21 – 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent No. 4,352,340 to Strubelt.

5. Re – claims 1 and 15, Strubelt discloses the claimed invention including a one-piece litter box A comprising a container 10 have a base wall 20 with side walls 22 forming a hollow interior space, a top opening, best seen in FIG. 2, for example, formed by upper edges of the

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sidewalls 22, an entrance opening 24 formed in one of the sidewalls 22, the opening 24 being circular and having a diameter in the range of about eight inches to about 10 inches {at col. 1, line 66, (1:66) Strubelt discloses “approximately three (3) inches of litter material”, which, from FIG. 2, measures just over 1 cm; the opening 24 in the same FIG. measures a full three (3) times that, which means that the opening 24 measures  $\approx 9$  inches (3 X 3 in.) in diameter, which is about 8 to about 10 inches}, the opening 24 being spaced below the top opening and, using the measurements from before, spaced at least 6 in. from the base wall 20, the opening 24 being laterally centered on the sidewall 22 in which the opening 24 is formed, best seen in FIG. 1, for example, the sidewalls 22 being free of any openings other than opening 24, the opening 24 being free of any coverings, and the sidewalls 22 form a height of the container 10 which substantially prevents the animal from seeing over the sidewalls 22. Re – the “whereby” statement, the animal is apparently facing the opening 24 while within the hollow interior space, as seen in FIG. 2, for example. Alternatively, Strubelt does not explicitly state the opening 24 being at least 6 in. from the base wall 20. However, measuring as before from the bottom of the base wall 20 to the bottom of the opening 24, it would appear that the distance is nearly 6 in., and the difference between nearly 6 in. and at least 6 in. in the realm of litter boxes would be obvious to one of ordinary skill in the art at the time the invention was made, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

6. Re – claims 2 and 16, Strubelt discloses the sidewalls 22 being continuous except for the entrance opening 24.

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7. Re – claim 3, since Strubelt discloses at least 6 in. to the bottom of the opening 24 and  $\approx$  9 in. for the diameter, then from FIG. 2, it is clear that the height of the container 10 is at least 15 in. ( $6 + 9 = 15$ ).

8. Re – claims 9 and 17, using the same base measurements from FIG. 2, Strubelt discloses the center of the entrance opening 24 being spaced above a bottom of the container 10 a distance of roughly 25 percent of the height of the container 10. Lacking any showing of criticality of this dimension, it would be obvious to one of ordinary skill in the art at the time the invention was made to space the opening 24 as any percentage of the overall height of the container as a function of the overall height of the container. In other words, it would not matter to a cat how tall the container was, rather the height and diameter of the opening allowing entrance.

9. Re – claims 10 and 18, since the lid 12 disclosed by Strubelt is removable, it is not part of the structure of the container 10 itself, and, therefore, the top opening is entirely open and free of any covering.

10. Re – claims 11 and 19, from FIG. 1, it appears that the container 10 is opaque. However, Strubelt does not explicitly state that the container is made from a plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the container from a plastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. This is further evidenced by the fact that one would experience great difficulty attempting to find a litter box made of anything other than a plastic material today.

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11. Re – claims 21 and 23, Strubelt discloses an interior surface being seamless, interfaces between sidewalls being rounded, and interfaces between the base wall and the sidewalls being rounded, as best seen in FIG. 2, for example.

12. Re – claims 22 and 24, while Strubelt discloses disposing a liner on which to place litter, the recitation of a new intended use for an old product does not make a claim to an old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In this case, the device itself is to be used as a litter box for felines, and one of ordinary skill in the art at the time the invention was made would require no further impetus than either a shortage of liners or a cost prohibitive supply of liners to hit upon the idea of using the device without a liner. In fact, most commercially available litter boxes are designed to be used without liners.

13. Claims 12 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Strubelt in view of US Patent No. 6,196,156 B1 to Denesuk et al.

14. Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the container is molded of a plastic material including an antimicrobial material. Denesuk et al. teach an article 114 molded of a plastic material including an antimicrobial material; 4:40 – 5:55 in the same field of endeavor for the purpose of inhibiting microbes in domestic animal bedding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the container being molded of a plastic material including an antimicrobial material as taught by Denesuk et al. in order to inhibit microbes.

15. Claims 13 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Strubelt in view of US Patent No. Des. 380,880 to Reid.

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16. Re – claim 13, Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the upper edges of the sidewalls form a lip having a round upward-facing surface. Reid teaches upper edges of sidewalls forming a lip having a round upward-facing surface in the same field of endeavor for the purpose of handling the litter box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the upper edges of sidewalls forming a lip having a round upward-facing surface as taught by Reid in order to handle the litter box.

17. Re – claim 14, Strubelt discloses the invention substantially as claimed as applied above. However, Strubelt does not disclose wherein the upper edges of the sidewalls form a lip having a width of no more than one-half inch. Reid teaches the upper edges of the sidewalls forming a lip having a width of substantially no more than one-half inch in the same field of endeavor for the purpose of strengthening the structure of the litter box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strubelt to include the upper edges of sidewalls forming a lip having a width of no more than one-half inch as taught by Reid in order to strengthen the structure of the litter box.

#### ***Response to Arguments***

18. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

1/8/05



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